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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/221,099	12/28/1998	JAY S. WALKER	WD2-98-112	5153

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/221,099

Applicant(s)

WALKER ET AL.

Examiner

Pierre E. Elisca

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 20-22, 24-26, 80, 86 and 87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 20-22, 24-26, 80, 86 and 87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This Office action is in response to Applicant's Appeal/Brief, filed on 2/18/2004.
2. Regarding the status of the claims in the present application, the Examiner has found new prior art. The Examiner is obliged to apply the newly found prior art. Thus, the finality of the prior Office action has been withdrawn and a new rejection follows. The Examiner regrets the delayed process of the application. Accordingly, claims 17, 18, 20-22, 24-26, 80, 86 and 87 are remain pending in the application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-26, 80, 86 and 87 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Fraser (WO 97/08638) and **Deaton et al** (U.S. Pat. No. 6,684,195) in view of West et al. (U.S. Pat. No. 5,845,259) and further in view of Jones (U.S. Pat. No. 5,832,458).

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As per claims 17, 18, 20-22, 24-26, 80, 86 and 87 Deaton substantially discloses a point of sale terminal that provides customer promotion (which is equivalent to Applicant's claimed invention wherein said a method/system for promoting a sale of a substitute product, comprising:

receiving transaction data regarding an original product presented for purchase by a consumer at a point of sale terminal (see., abstract, lines 2 and 3, wherein said a product to be purchased and generating a signal representing the code on the product to be purchased, page 4, page 8);

transmitting the transaction data to a remote server of a manufacturer during a transaction session for determination of a possible offer to the consumer (see., abstract, lines 3 and 4, wherein said this signal is then used to retrieve the price of the product from a first memory, it is also obvious to know that a server or computer is needed in order to process the code or the user's request, page 4, page 8);

upon receiving of information regarding a product from the remote server, offering the product to the consumer before the transaction session terminates (see., abstract, lines 4 and 5, wherein said the signal is also used to identify a product which is equivalent to the product to be purchased and to retrieve the price of the equivalent product, page 4, page 8, page 9 and 15); and

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consummating a sale of the original product if at least one of no information regarding the product is received from the remote server, consumer declines the offering, and consummating a sale of the substitute product upon acceptance by the consumer (see., abstract, line 7, wherein said the price difference then be used by a consumer to decide if the equivalent product is a better value than the product he or she intended to purchase, page 4, page 9 and page 15). It is to be noted that Fraser fails to explicitly disclose a substitute product offer. Deaton discloses a selective incentive point-of-sale marketing in response to customer shopping histories where the manufacturer may then be substituting one cookie in the product line for another (see., abstract, col 104, lines 45-62). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Fraser by including the limitation detailed above as taught by Deaton because such modification would provide develop customer profiles useful in targeting and implementing marketing and promotions.

Fraser and Deaton fail to disclose the used of a remote server manufacturer and a remote retailer for transmitting transaction data.

However, **West** discloses a point of sale including a terminal having a data reader transaction data, a remote retailer and manufacturer or remote server retailer manufacturer coupon redemption (see., col 2, lines 24-30, col 3, lines 31-37, col 4, lines 20-22). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a retailer and a manufacturer remote server as

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taught by **West** into the point of sale terminal of **Fraser and Deaton** because it would have been to eliminating the need for the manual collection of data transmission (see., West, col 3, lines 35-37). As specified by Applicant's representative in the Amendment filed on 2/15/2002, page 3, that neither West nor Fraser discloses a manufacturer that is actively involved in retail transactions and sales efforts.

Jones discloses an audit system processor that is remotely located from the retail store for receiving the processed retail sales transaction data for subsequent use by MANUFACTURER see., abstract, col 1, lines 32, col 3, lines 6-28 (which is equivalent to Applicant's arguments detailed above. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of West, Fraser, and Deaton by including the limitation detailed above as taught by Jones because such modification would provide the teachings of West, Fraser, and Deaton with the enhanced necessary to ensure the accurate and timely settlement between consumer goods manufacturers and the retailers of their products.

As per claim 19, Fraser discloses the claimed method wherein the transaction data includes at least one of: product price, product identifier and product UPC code (see., abstract, figs 1, 2, 4-6).

As per claim 23, Fraser discloses the claimed method wherein the offering comprises transmitting information regarding the substitute product to the consumer via at least one of: a printer, a display terminal and a speaker (see., abstract, fig 4).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre Eddy Elisca

Primary Patent Examiner

May 25, 2004